

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of Vincent Douglas : Group Art Unit: 2875
Serial No. 10/544,245 : Examiner: Robert J. May
For: DISPLAY APPARATUS : 371(c) Date: February 6, 2004

PRE-APPEAL REQUEST FOR REVIEW

Dear Sir:

Applicant respectfully requests a pre-appeal review of the final rejections made in the Office Action mailed on November 27, 2007. Upon carefully considering the following comments and arguments of record (all of which are incorporated herein by reference), the panel will find that the present Examiner has committed the following factual and legal errors in rejecting the claims.

In the Action, the inventions of claims 1, 37, and their progeny are rejected as obvious in view of the Freeman and De La Huerga references. As the Examiner acknowledges, Freeman fails to disclose a display member removably attached to a control unit. Thus, citation is made to the secondary De La Huerga reference as allegedly disclosing a "control unit" (element 204) releasably secured to a "distal portion" of a display member so that the display member "can be disposed of and may be replaced to suit the user." Allegedly, it would therefore be obvious "to modify the display apparatus of Freeman with a control unit that is releasably secured to the display member of Freeman so that the display member can be disposed of and the more expensive controller can be reused for a different patient in a hospital environment and the [sic] can be salvaged if the display portion of the bracelet is irreparably damaged."

Respectfully, this is not a proper reason for combining the elements of these references in the manner proposed by the Examiner.¹ Specifically, the explanation provided for making the combination of elements is that the "display member can be disposed of and the more expensive controller can be reused for a different patient in a hospital environment and the [sic] can be salvaged if the display portion of the bracelet is irreparably damaged." However, the device of De La Huerga already meets these objectives. A need for disposing of a "display member" but

¹ See Memorandum of Margaret A. Focarino, Deputy Commissioner for Patent Operations, May 3, 2007 ("in formulating a rejection under 35 U.S.C. 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed . . .") (emphasis added).

retaining an associated “controller” is simply not a proper reason for using a completely different type of display member required by Applicant’s claims, and no “rational underpinning” or substantial evidence cited supports the Examiner’s position. Indeed, the *KSR* decision invoked by the Examiner actually supports the Applicant’s position, since it recognizes that “merely demonstrating that each of its elements was, independently, known in the prior art” is insufficient to establish obviousness.²

The Examiner also commits error by disregarding the disparate nature of the devices disclosed in the cited references. The device 10 of Freeman includes a flexible LCD display strip 12 and other electronic components, none of which is characterized as being “removably attached” to each other in any way.³ Undoubtedly, such an LCD strip 12 would be more expensive than the basic “disposable” inexpensive type of strap for receiving printing used in the invention of De La Huerga (which it expressly teaches “cannot be removed” without being destroyed; see the Abstract and col. 5, lines 56-57). Utilizing the LCD strip 12 of Freeman in the De La Huerga arrangement would defy the point of using a disposable strap that does not include relatively costly components, such as circuitry or the like. In other words, De La Huerga when considered as a whole teaches away from using the kind of “display member” proposed in Freeman in view of the desire to have the user intentionally destroy the strap when removing it. The Examiner’s position relies entirely on ignoring the teachings of the references as a whole, which is reversible error. *See MPEP § 2141.03 (“A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.”) (emphasis added); In re Gurley, 27 F.3d 551, 553, 31 USPQ2d 1130 (Fed. Cir. 1994) (“A reference ... teach[es] away when a person of ordinary skill, upon reading the reference, would be ... led in a direction divergent from ... [that] taken by the applicant.”).*

For the foregoing reason alone, Applicant has thus rebutted the Examiner’s *prima facie* case of obviousness. *Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1369 (Fed. Cir. 2007) (holding that

² *See KSR Int’l Co. v. Teleflex, Inc.*, 82 USPQ2d 1385 (2007) (holding that in formulating a rejection under 35 U.S.C. 103(a), it was “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” and further stating that “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art . . .”) (emphasis added).

³ *See Dorel Juvenile Group, Inc. v. Graco Children’s Prods.*, 429 F.3d 1043, 1045 (Fed. Cir. 2005) (affirming a holding that the claim term “removably attached” referring to a seat “carries with [it] an implication that the detachment or unsecuring process not do violence to the seat.”) (emphasis added).

rebutting a *prima facie* case of obviousness involves evidence “that the prior art teaches away from the claimed invention in any material respect”). In response, the Examiner posits “De La Huerga is used merely to show that it is well within the skill in the art to have a controller that is detachable for various reasons.” This selective reliance of the teachings of this reference, without considering the evidence that it “as a whole” teaches away from the combination, also constitutes reversible error.

Regardless of this teaching away, nothing in the record establishes that a skilled artisan viewing the reference teachings would arrive at an operable form of the claimed invention. The strap of De La Huerga does not in any way include a flexible electronic pixel array of any sort. Rather, the “viewing surface” 116 of the strap is intended to have printed identification information (see col. 6, lines 31-34 and col. 11, lines 28-30). De La Huerga admittedly suggests providing a display on the transponder (col. 13, lines 47-53 and display 424 on the transponder 420 in Figure 11), but that display is plainly not on any flexible display member, as required by claim 1. There is also no teaching whatsoever that the transponder of De La Huerga is capable of operating any flexible pixel array, since it merely “can receive information and transmit information to remote hand held electronic devices....” (col. 6, lines 3-4). For this reason, this transponder 420 is not properly considered a “control unit” for controlling any flexible pixel array, as expressly claimed. *See In re Cortright*, 165 F.3d 1353, 1358, 49 USPQ2d 1464 (Fed. Cir. 1999) (“Although the PTO must give claims their broadest reasonable interpretation, this interpretation must be consistent with the one that those skilled in the art would reach.”) (emphasis added). Freeman as noted above does not remotely teach or suggest a removable control unit for a flexible pixel array. Thus, neither of the references teach or suggest a limitation of the claims, and a *prima facie* case of obviousness is lacking for this added reason.

The Examiner’s position also disregards the fact that the information stored by the device of De La Huerga comprises confidential medical history and, unlike the patient’s printed name, would not be read from the strap. Indeed, one of the main reasons for using a transponder in De La Huerga is to allow stored information to be read on a remote device, thereby avoiding the need to rotate a patient’s wrist to read the information from the strap (col. 2, line 60 to col. 4, line 45; see also col. 5, lines 56-59, “it would be advantageous to have a patient identification mechanism which is ... accessible without reorientating a patient or the bracelet.”). Making this stored information available on the display 12 of Freeman defeats these purposes of the De La Huerga arrangement.

Furthermore, no evidence in either Freeman or De La Huerga, or otherwise in the record,

establishes that any “display member” should be made readily removable from any control unit so that it can be replaced “with an alternative design or size” of a display member to suit the user. The teaching of De La Huerga is limited to merely replacing a transponder on a strap, generally. Indeed, a reason De La Huerga proposes a removable transponder is because of the intended destruction of the associated bracelet. Thus, De La Huerga actually discourages providing an array of alternative display members that a user can pick and choose from for use as fashion accessories, and Freeman is completely silent as to such.

Finally, the Examiner’s position constitutes error because it disregards the fact that the proposed combination would require a complete reworking and redesign of the devices. As but one example, Freeman contemplates including a smart card reader in the form of a communication element 16 that is integrated at one end of the strap 22. In stark contrast, the transponder 420 of the De La Huerga device communicates information between a memory chip 140 on the strap and a separate device. Aside from solving no legitimate technical problem, replacing the integrated communication element 16 of Freeman with the removable transponder 420 of De La Huerga, or vice-versa, would require a complete redesign of the devices to operate in a manner different from what is intended. Such a requirement for redesign has been long held inimical to obviousness.⁴

Claims 39, 41, and their progeny stand rejected over the combined teachings of Freeman and GB 2,373,990 to Broderick. Freeman as discussed above is concerned with a general purpose display apparatus and uses a sophisticated type of display technology, as compared with the simple LED arrangement used in Broderick for use in connection with a safety arm band used to increase the visibility of the wearer. A safety arm band is intended to be a durable, yet inexpensive and disposable item. Thus, it would not be desirable to use the more expensive (and delicate) display

⁴ See *In re Ratti* 123 USPQ 349 (CCPA 1959) (finding nonobviousness because a “suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [reference 1] as well as a change in the basic principles under which the . . . construction was designed to operate”); see also *Ex parte Chicago Rawhide Manufacturing Company*, 223 USPQ 351(Bd. Pat. App. & Inter. 1984) (“In our view the here claimed subject matter would not have been obvious within the meaning of 35 USC 103 based solely on the [reference]. . . . [I]n order to meet the terms of the claims on appeal, the elements of the . . . device would have to be arranged in a manner different from that disclosed The elements of the reference would also be required to coact differently from the way they coact in the arrangement disclosed by the reference. The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness.”).

technology of Freeman in such an arrangement.

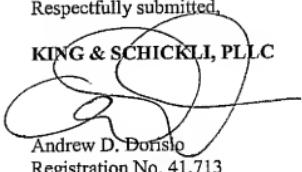
Moreover, the arm band of Broderick is designed for use under low light conditions (see pages 5-6), while the Freeman device is intended to display time and other information that would not be visible in low light conditions. Accordingly, the ease of application considerations of Broderick would not be of concern to Freeman. Broderick's outer strip is also highly reflective and includes only intermittent LED displays, and thus it would be counter intuitive for a skilled artisan to consider this type of display in combination with the display 12 of Freeman.

Claims 40 and 42 add the requirement that the axially straight, transversely concave display member is removably attached to the control unit and thus can be detached and replaced with an alternative design or size to suit the user. Citing Freeman, Broderick, and De La Huerga, the Examiner contends the inventions of these claims are obvious. However, nowhere in the statement of the rejection does the Examiner even mention Broderick, or provide a reason why a skilled artisan would provide a removable display member that is initially straight and concave in the transverse direction for use with either the devices of Freeman or De La Huerga. Indeed, Broderick includes a simple LED arrangement, and nothing even remotely suggests that the complex display technology of Freeman could be used with the Broderick strap (and, as noted above, a redesign to incorporate this display technology into the arm band of Broderick, which includes a "self-coiling metal strip 8", would require a substantial redesign). Accordingly, the Examiner has committed error by failing to establish *prima facie* obviousness for the inventions of claims 40- 42.

In summary, Applicant has identified errors that would lead to a reversal of the extant rejections on appeal. Upon careful review and consideration, it is believed the panel will agree that the Examiner has committed the foregoing reversible errors and find the inventions of all claims patentable over the cited prior art. In the event any additional fee is due for processing this Request document or otherwise, please debit it from Deposit Account No. 11-0978.

Respectfully submitted,

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Application Number

10/544,245

Filed

08/02/2005

First Named Inventor

Vincent Douglas

Art Unit

2635

Examiner

Robert J. May

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

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See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
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